UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,348	01/30/2004	Christopher R. Dance	D/A3127	5238

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EXAMINER
RUSH, ERIC

ART UNIT	PAPER NUMBER
2624	

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01/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/767,348	DANCE ET AL.
	Examiner	**Art Unit**	
	Eric Rush	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 November 2007</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>08 August 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☒ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. <u>20071231</u>.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is responsive to applicant's amendment and remarks received on 28

November 2007. Claims 1 - 20 are currently pending.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1 – 17 and 19 – 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by Simske U.S. Patent No. 7,234,106.

-       With regards to claim 1, Simske teaches a method for automatically

        combining a digital image with text data, comprising: (a) receiving

        electronic data comprising a digital image; (Simske, Figs. 5 & 7, Column 3

        Lines 40 - 54) (b) automatically classifying the image according to a

        predetermined set of categories; (Simske, Column 3 Lines 54 – 65,

        Column 4 Lines 3 - 17) and (c) automatically selecting text data from a

repository that matches the category of the image according to a predetermined criterion; (Simske, Column 4 Lines 25 – 52) wherein (a), (b), and (c) are executed on one or more servers; (Simske, Column 8 Lines 30 - 36) and wherein text data is not metadata. (Simske, Column 3 Lines 10 – 16, "annotation data 203 may be directly added to image")

- With regards to claim 2, Simske teaches the method according to claim 1, wherein the selected text data matches a predetermined recipient profile. (Simske, Column 2 Line 65 - Column 3 Line 4)

- With regards to claim 3, Simske teaches the method according to claim 2, wherein said selecting at (c) further comprises automatically selecting a recipient profile according to a predetermined criterion. (Simske, Column 4 Lines 25 – 36 and Lines 37 - 45)

- With regards to claim 4, Simske teaches the method according to claim 3, wherein the predetermined criterion is the sender of the electronic data. (Simske, Column 2 Line 65 – Column 3 Line 4)

- With regards to claim 5, Simske teaches the method according to claim 1, further comprising automatically combining the image and the selected text data to form a combined document. (Simske, Column 3 Lines 10 - 19)

-   With regards to claim 6, Simske teaches the method according to claim 1, further comprising at least one of automatically initiating printing of the combined document and sending the combined document. (Simske, Column 8 Lines 20 – 36, "In other embodiments, the executable instructions or software code may be communicated via a data signal from a communication medium, such as the Internet...")

-   With regards to claim 7, Simske teaches the method according to claim 1, wherein said receiving at (a) comprises receiving the electronic data over a network via at least one of electronic mail and a digital telephone network. (Simske, Column 8 Lines 20 – 36, "In other embodiments, the executable instructions or software code may be communicated via a data signal from a communication medium, such as the Internet...")

-   With regards to claim 8, Simske teaches the method according to claim 1, wherein said receiving at (a) further comprises requesting and receiving at least one of a recipient name and a recipient profile. (Simske, Column 2 Line 65 – Column 3 Line 4)

-   With regards to claim 9, Simske teaches the method according to claim 1, wherein said receiving at (a) further comprises testing the electronic data

regarding at least one of authentication, authorization with respect to a potential recipient, and content of the image. (Simske, Column 3 Lines 59 – 65, Simske teaches testing the data for content, i.e. text regions and image regions)

- With regards to claim 10, Simske teaches the method according to claim 1, wherein said classifying at (b) is preceded by automatically placing the electronic data on a queue or schedule for classification. (Simske, Column 3 Lines 54 – 59)

- With regards to claim 11, Simske teaches the method according to claim 1, wherein the text data in the repository is classified according to the predetermined set of categories and wherein said selecting at (c) further comprises searching the repository for text data comprising a keyword associated with the category of the image. (Simske, Column 4 Lines 25 – 36)

- With regards to claim 12, Simske teaches the method according to claim 1, wherein said selecting at (c) further comprises searching the repository for text data comprising a keyword associated with the category of the image. (Simske, Column 4 Lines 25 – 36)

- With regards to claim 13, Simske teaches the method according to claim 1, wherein said selecting at (c) further comprising classifying the image according to a predetermined set of subcategories within a category. (Simske, Column 3 Line 59 – Column 4 Line 2 and Column 4 Lines 25 – 45)

- With regards to claim 14, Simske teaches the method according to claim 1, wherein the electronic data further comprises image content information data and wherein said classifying at (b) further comprises extracting the image content information data. (Simske, Column 3 Line 59 - Column 4 Line 2)

- With regards to claim 15, Simske teaches the method according to claim 14, wherein the image content information data comprises one or more of positional and temporal information regarding the image, and wherein said classifying at (b) further comprises comparing at least one of the position and temporal information with a lookup table. (Simske, Column 4 Lines 36 – 45)

- With regards to claim 16, Simske teaches the method according to claim 1, wherein said classifying at (b) further comprises extracting content information from the image. (Simske, Column 3 Line 59 - Column 4 Line 2)

- With regards to claim 17, Simske teaches the method according to claim 16, wherein extracting content information from the image comprises applying at least one of a kernel image categorization method and a multi-classifier method. (Simske, Column 3 Line 59 – Column 4 Line 2 and Column 4 Lines 25 – 36, Simske employs a multi-classifier method)

- With regards to claim 19, Simske teaches an apparatus including one or more servers for automatically combining a digital image with text data, (Simske, Column 2 Lines 27 – 51 and Column8 Lines 20 – 36) comprising: a receiving means on at least one of the one or more servers configured to receive electronic data comprising a digital image, (Simske, Fig. 1, Column 3 Lines 40 – 54) a classification means on at least one of the one or more servers configured to automatically classify the image according to a predetermined set of categories, (Simske, Column 3 Lines 54 – 65, Column 4 Lines 3 - 17) and a selection means on at least one of the one or more servers configured to automatically select text data from a repository that matches the category of the image according to a predetermined criterion; (Simske, Column 4 Lines 25 – 52) and wherein text data is not metadata. (Simske, Column 3 Lines 10 – 16, "annotation data 203 may be directly added to image")

-        With regards to claim 20, Simske teaches the apparatus according to

claim 19, further comprising a combing means configured to automatically

combine the image and the selected text data to form a combined

document. (Simske, Column 3 Lines 10 – 19)

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
          obviousness or nonobviousness.

5.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simske

U.S. Patent No. 7,234,106 in view of Cok et al. U.S. Patent No. 6,822,756.

-        With regards to claim 18, Simske teaches a method for automatically

combining a digital image with text data, comprising: (a) receiving

electronic data comprising a digital image; (Simske, Figs. 5 & 7, Column 3

Lines 40 - 54) (b) automatically classifying the image according to a predetermined set of categories; (Simske, Column 3 Lines 54 – 65, Column 4 Lines 3 - 17) and (c) automatically selecting text data from a repository that matches the category of the image according to a predetermined criterion; (Simske, Column 4 Lines 25 – 52) and wherein (c), (b) and (c) are executed on one or more servers. (Simske, Column 8 Lines 30 - 36) Simske fails to teach wherein text data is at least one of a newspaper, book, magazine, brochure, pamphlet or advertisement. Cok et al. teach wherein text data is at least one of a newspaper, book, magazine, brochure, pamphlet or advertisement. (Cok et al., Figs. 9, 10, & 11, Column 5 Lines 1 - 56) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Simske with the teachings of Cok et al. This modification would have been prompted because Simske teaches adding any kind of text data to a digital image. In order to add more variety and a larger cache of text data to the existing method and system of Simkse the inclusion of text data as taught by Cok et al. would accomplish that goal with a reasonable expectation of success.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-     Watkins et al. U.S. Patent No. 5,459,819; which is directed to a system for custom imprinting a variety of articles with image obtained from a variety of different sources.

-     McIntyre U.S. Patent No. 7,092,966; which is directed to a method for creating an image product having predefined criteria.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Rush whose telephone number is (571) 270-3017. The examiner can normally be reached on 7:30AM - 5:00PM (EST).
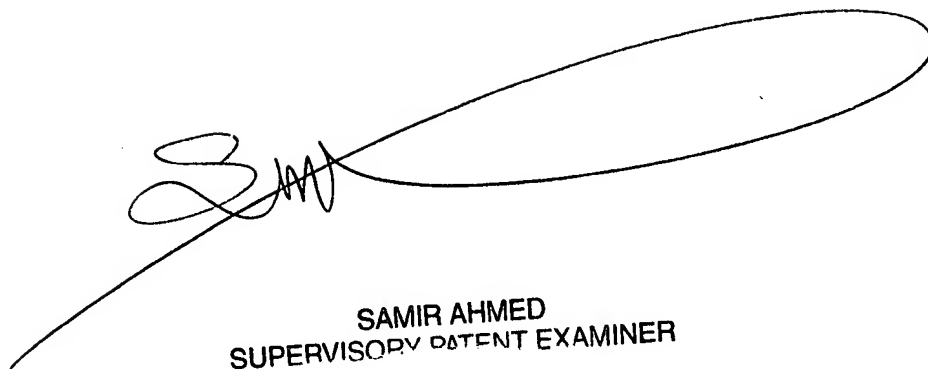
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on (571) 272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ER

SAMIR AHMED
SUPERVISORY PATENT EXAMINER